REMARKS

This Response is being filed in response to the Office Action dated June 2, 2004. Enclosed separately herewith is a Request for Extension of Time to and including October 2, 2004, and including October 4, 2004 since October 2 fell on a Saturday.

35 U.S.C. §103(a)

In the Office Action mailed June 2, 2004, the Examiner states that claims 1-3, 5-9, 12, and 22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,722,319, issued to Hirano in view of U.S. Patent No. 4,542,691 issued to Kokrhanek. The Examiner alleges that the patent to Hirano teaches a method and system of an embossing apparatus, but that Hirano may not be considered as a stencil and form pair as presently claimed. The Examiner further states that the patent to Kokrhanek allegedly teaches an embossing system for embossing and decorating various articles. See Office Action, p. 2.

35 U.S.C. §103. There must be a basis in the art for combining or modifying the references

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *see, also*, MPEP §2143.01.

Hirano discloses a press roller that utilizes a stamping operation that can be performed simply by imparting axial rotation to the press roller, unlike the "prior art" technology, which applies a pressing load with a lever, the force required for stamping is greatly reduced so that women, children and the like having limited physical strength can easily stamp embossed patterns with clear outlines. See, col. 4, lines 50-57. The structure is provided with a control mechanism. The control mechanism controls the gap between the press roller and the rotating roller by controlling the position of the shaft of the rotating roller. See, col. 5, lines 65-67 and col. 6, lines 1-3. The Examiner cites Figs. 24-27 and col. 9, line 66-col. 10, line 37. Fig. 24 is an exploded perspective view of an embossing pattern stamping die. The embossed pattern stamping die is provided with a frame member. The frame member is provided with a hinge mechanism for being folded over. The frame member is also provided with at least two open portions, which are surrounded by frame portions at the left and the right of the hinge

mechanism. The indented die member and the projected member are positioned facing the open portions and are connected to the frame portions at the edges. The indented die member and the projected die member are connected to the frame member by means such as Velcro adhering material or indentation/projection connecting means. See, col. 10, lines 1-14.

Kokrhanek is directed to a method of stamping by means of hot stamping press decorations on articles of various types. See col. 1, lines 5-8. More particularly, the article to be decorated is a stiff body, the patrix is disposed between the upper stamping member (upper hot plane or hot roller) of the hot stamping press and the hot stamping foil. Therefore, when the press is operated, the patrix pushes the foil into the perforations of the matrix and causes said foil to adhere to the article's surface to be decorated in the areas of the perforations of the matrix and to transfer the colored layer of the foil to the article to be stamped.

Therefore, the disclosure in Hirano is directed to an embossing pattern utilizing a roller press allowing women, children and the like having limited physical strength to easily stamp embossed patterns with clear outlines. Kokrhanek discloses a press utilizing a hot stamping press and hot stamping foil to transfer the colored layer of the foil to the article to be stamped.

In stark contrast, disclosed in the present application is an embossing system comprising a sleeve having a first part and a second part, a stencil being adapted to be positioned between the sleeve first part and sleeve second part, and a form being adapted to be positioned between the stencil near the sleeve first part or the sleeve second part. Applicant respectfully traverses the Examiner's rejection of claims 1-3, 5-9, 12, and 22 under 35 U.S.C. §103(a) as being unpatentable over Hirano in view of Kokrhanek. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent come teaching, suggestion or incentive supporting the combination of the prior art. *See, ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). There simply is no teaching or suggestion or incentive to support the combination of Hirano with Kokrhanek. Hirano discloses an embossed pattern stamping die with a frame member. The frame member is provided with a hinge mechanism for being folded over. The roller press of Kokrhanek which utilizes a hot stamping press to adhere a hot stamping foil, which consists of a backing layer, a

stripping layer, a colored layer and a thermal adhesive layer facing the surface of the article to be decorated (see col. 3, lines 9-26) simply would not be combined with the embossed pattern stamping die disclosed in Hirano by one skilled in the art. Hirano does not disclose any means of heating in the press to utilize a thermal adhesive layer and a hot stamping foil, as disclosed in Kokrhanek. In addition, Hirano solves the problems of only one embossed pattern being obtained with one stamping operation, and addressing the need of a plurality of embossed patterns on one sheet to be stamped and the required pressing force for stamping at a level for women, children and the like having limited physical strength. See, col. 1, lines 24-40. In contrast, Kokrhanek is directed to solving the problem of addressing the prior art need because of considerably expensive metal or silicone rubber printing plates that are required in vertical hot plane presses or hot roller presses utilized in hot stamping for making decorations on articles, particularly when a hot stamping foil is interposed between the printing plate and the article so that a colored thermal adhesive layer of the foil is reproduced on the surface of the article. See, col. 1, lines 5-40. Kokrhanek includes an alternative embodiment shown in Figs. 5 and 6 wherein the article to be decorated is deformable per se, for example, fabrics, felts and hides, or in which the article becomes deformable with heat, for example, plastics, paper, cardboard, lacquers and thin wooden foils.

Therefore, it is respectfully submitted that there is no motivation, suggestion or teaching to combine Kokrhanek with Hirano to support the combination of those references to render claims 1-3, 5-9, 12, and 22 obvious under 35 U.S.C. §103(a). There simply would be no desirability to combine Kokrhanek with Hirano.

The arguments outlined above are repeated herein regarding the Examiner's rejection of claims 4, 10, and 11 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hirano in view of Kokrhanek as applied to claims 3 and 9 and further in view of U.S. Patent No. 4,979,613 issued to McLaughlin et al. McLaughlin is directed to a separable fastening device wherein the inventors are solving the problem of tacky or sticky surfaces of the prior art that are prone to contamination by dirt, lint, dust, and the like which reduce the adhesive properties of the fastener, and ultimately rendering the fastener completely useless for its intended purpose. Further, the inventors were trying to achieve a fastening device that was capable of opening and

closing more quietly. See, col. 2, lines 32-48. Further, the article disclosed in McLaughlin is a personal package of facial tissues. See, col. 4, lines 56-60. There simply is no basis for combining an embossing frame as disclosed with Hirano with a hot press for utilizing hot stamping foils with thermal adhesive layers with a fastening mechanism utilized in facial tissue packages.

The arguments relating to the combination of references Hirano and Kokrhanek are repeated herein relating to the Examiner's rejection to claim 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hirano in view of Kokrhanek as applied to claim 9 and further in view of U.S. Patent No. 5,188,026 issued to Fuqua et al. Fuqua et al. is directed to a pin register system for screen printers especially an apparatus which is designed to register in alignment multiple screens for printing an image, because images in the printing sequence are printed in a layered fashion to produce a single image it is necessary that each subsequent image is precisely registered. See, col. 1, lines 5-9 and lines 39-42. It is respectfully submitted that one skilled in the art would not look to combine a pin register system for screen printers, combined with hot roller presses utilizing hot stamping foil with thermal adhesive layers, combined with an embossed patterns stamping apparatus.

Regarding claims 14-21, the Examiner rejected these claims under 35 U.S.C. §103(a) as allegedly being unpatentable over Hirano in view of Kokrhanek and further in view of U.S. Patent No. 5,590,910 issued to Meth. Meth discloses a collapsible all-weather clipboard assembly so that the clipboard may be conveniently used in all weather conditions when it is often difficult to prevent the writing materials from becoming wet from rain and snow as well as from becoming windblown. See, col. 1, lines 5-21. It is respectfully submitted that there is no basis that one skilled in the art would combine a collapsible clipboard as disclosed in Meth with the hot press utilizing hot stamping foil in Kokrhanek with the embossing system disclosed in Hirano.

The Proposed Combination of Kokrhanek with Hirano Creates an Inoperable Reference That Teaches Away from the Combination

References that teach away cannot serve to create a prima facie case of obviousness. If references taken in combination would produce a "seemingly inoperable device"

the Federal Circuit has held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. See, *McGinley v. Franklin Sports Incorporated*, 262 F.3d 1339 (Fed. Cir. 2001).

In Hirano, an embossed pattern stamping die has a frame member 340 with a hinge mechanism 343 for being folded over. The frame member 340 is also provided with at least two open portions 344 and 345. The indented die member and the projected die member are positioned facing the open portions 344 and 345 and are connected to the frame portions at the edges. The embossing combination in Kokrhanek utilizes a hot stamping foil 27 which is deformed and pushed into perforations 26 but it is the article 23 which is deformed and pushed into the perforations 26 of the matrix 25 and causes the portion of the article surface 24 to be decorated to adhere to the surface of the foil in the area of the perforations 26 due to the deformation of the patrix 28. See, col. 4, lines 5-18.

The Examiner states that it would have been obvious to one of ordinary skill in the art to provide the embossing system of Hirano with the stencil and form pair along with the foil having a color layer appropriately disposed as taught by Kokrhanek in order to create an embossed and decorative color design on the embossing material. The Applicant respectfully traverses the Examiner's position and respectfully submits that the combination of the "stencil and form pair along with the foil having a color layer appropriately disposed as taught by Kokrhanek" with the embossing system of Hirano simply would not be an operable embossing system and certainly would not result in an embossing system as presently claimed. In Kokrhanek, if article 23 is deformed and pushed into the perforations 26 of the matrix 25, causing the portion of the article surface 24 to be decorated to adhere to the surface of the foil in the area of the perforations 26 due to the deformation of the patrix 28, then the resulting article would be an article 23 with foil 27 adhered to the article 23 at those areas wherein the article 23 was deformed through the perforations 26. At that point, the matrix 25 would be sandwiched between the article 23 and the foil 27. Therefore, the resulting article would include a sandwiched structure of the article 23, the matrix 25, and the foil 27. It is not explained in the Kokrhanek reference whether the resulting sandwiched structure is the end product. Nevertheless, it is evident in the Kokrhanek reference that since the patrix 28 is a resilient

material that is to be deformed under pressure to push the article 23 into the perforations 26, it is clear that solid pieces 21 and 22 are required to provide the required force and counterforce for the hot forming process of Kokrhanek to work. If the matrix and patrix were used in the embossing frame disclosed in Hirano, the openings 344 and 345, along with the thickness of the frame 341 and 342 would not allow for an adequate structure to allow for force to be transferred through the frame of Hirano, with the openings, to a deformable patrix and matrix as disclosed in Kokrhanek. Further, in Hirano, as shown in Fig. 27, the embossing system is intended to provide a continuous feed of material to be embossed through the system. In contrast, in Kokrhanek, the material to emboss is not fed through the system in a continuous form since an additional manual operation is required to presumably remove the foil 27 from the embossed material 23. Further, the method and apparatus disclosed in Kokrhanek, as stated above, is directed to hot forming hot foil layers so as to permanently decorate an article. Figs. 5 and 6 in Kokrhanek allegedly disclose an embossed article, in combination with a hot foil layer, however, as stated above, the combination of the two references will produce an inoperable device.

An Obviousness Rejection Requires a Reasonable Expectation of Success

For the Examiner to establish prima facie obviousness, there must be a reasonable expectation of success. As stated above, the Federal Circuit requires that some reason or suggestion must be found in the prior art or other evidence of record that would have led one of ordinary skill in the art to produce the claimed invention in order to properly establish a prima facie case of obviousness. In *In re Clinton*, 527 F.2d 1226 (CCPA 1976), the Court first looked at the references to determine whether "the references by themselves…suggest doing what appellants have done." The Court next considered whether a person of ordinary skill in the art would have had a sufficient basis for the required expectation of success. Thus, the Court held that obviousness does not require absolute predictability but a reasonable expectation of success is *necessary*. Accordingly, when comparing the prior art to the claimed invention, one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led that person skilled in the art to do. Therefore, an "obvious to try" is an improper basis for a 35 U.S.C. §103 rejection when there is

no suggestion or expressed expectation of success in the prior art that would have led one to perform an experimentation in the first place.

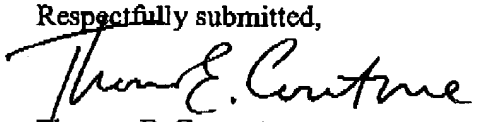
In the present case, as stated above, based on the different areas of technology and the attempts to solve different problems relating to the Kokrhanek reference versus the Hirano reference, and further yet, that the combined elements as the Examiner suggests would render the resulting embossing system inoperable, there is no suggestion or express expectation of success that would have led one to perform the experimentation of combining Kokrhanek with Hirano in the first place. Therefore, *inter alia*, the Examiner should withdraw the 35 U.S.C. §103 rejections as stated in the Office Action.

CONCLUSION

Therefore, in light of the arguments made above, it is respectfully requested that the Examiner withdraw the rejection regarding the presently pending claims and, in view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100 .

Respectfully submitted,



Thomas E. Coverstone
Reg. No. 36,492

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
60265683 v1